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PATENT APPLICATION  
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IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Quintin T. Phillips

Confirmation No.: 6319

Application No.: 09/932,638

Examiner: Yogesh C. Garg

Filing Date: 8/16/2001

Group Art Unit: 3625

Title: Image Forming Devices and Marketing Methods

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on 04/18/2006. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

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Respectfully submitted,

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IN THE  
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INVENTOR(S): Quintin T. Phillips

SERIAL NO.: 09/932,638

GROUP ART UNIT: 3625

FILED: August 16, 2001

EXAMINER: Yogesh Garg

SUBJECT: Image Forming Devices and Marketing Methods

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REPLY BRIEF UNDER 37 C.F.R. §41.41

SIR:

For at least the reasons presented in the Brief of Appellant and the arguments provided below, Appellants respectfully request reversal of the rejections of the claims and allowance of all pending claims.

**A. The 102 Rejection of Claims 9-16, 24-28 and 30.**

Appellants in their Brief and herein have identified four limitations of claim 9 which are not disclosed nor suggested by Sekizawa and the anticipation rejection is improper for at least this reason.

Appellants respectfully submit the Examiner has misinterpreted the teachings

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of Sekizawa in the Examiner's Reply, and the anticipation rejection of claims 9-16, 24-28 and 30 is improper. Appellants respectfully submit that Sekizawa fails to teach the limitations of communicating a request externally of the image forming device *using the image forming device*. Appellants respectfully assert that the teachings of agent unit 10 of Fig. 1 of Sekizawa external of printers P may not be fairly interpreted as teaching or suggesting limitations of the claimed image forming device inasmuch as agent unit 10 is not disclosed as a printer and the printer P of Sekizawa fails to disclose the claimed limitations. At page 10 of the Examiner's Answer, it is stated in line 4 that agent unit 10 is "integrated with" printer p via router 4. However, the Examiner fails to identify any teachings that the printer and agent unit are integrated. To the contrary, the printer and agent unit are a plurality of separate devices connected with a LAN 3. Furthermore, router 4 is depicted connecting agent unit 10 with the internet as opposed to providing integration of the agent unit with printer P and Appellants have failed to identify any teachings that the functions of router 4 integrate agent unit 10 and printer P. Appellants respectfully submit agent unit 10 does not include any printing functionality and the communications thereof fail to disclose or suggest the claimed *communicating the request using the image forming device* as defined in claim 9 and the claims are allowable for at least this reason.

At page 10 of the Examiner's Answer, the Examiner states that "[t]he function of the component agent unit 10 is also A request is an act of asking or sending a message for something to be done or given." Appellants are unsure if by such statement whether the Examiner is making an assertion regarding operations of agent unit 10 or merely defining what a request is. Appellants respectfully submit that agent unit 10 is not disclosed in Sekizawa as communicating a request and the Examiner has failed to identify any teachings of the prior art of agent unit 10 communicating a request as claimed. The mere communication of the status information by the agent unit 10 fails to disclose the communication of a request. Appellants respectfully submit that the Examiner has not identified teachings in the prior art that communication of status information may be considered to disclose or suggest communication of a request as claimed. Even if console 20 provides services, such does not teach or suggest that the communications of agent unit 10 are a request as claimed. Console 20 could perform such actions for any other

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numerous reasons and the actions of console 20 fail to disclose or suggest the agent unit 10 communicates a request as claimed. Appellants respectfully submit that the Examiner has failed to identify teachings in Sekizawa of the claimed *communicating the request using the image forming device* and Appellants submit that the Examiner's statement on page 11 that "it is quite obvious to the examiner that Sekizawa anticipates the recited limitation in claim 9" is not supported by the teachings of Sekizawa. Limitations of claim 9 are not disclosed by the prior art and claim 9 is allowable for at least this reason.

Claim 9 recites *receiving a message responsive to the communicating the request*. The Examiner on page 11 identifies col. 19, lines 6-14 of Sekizawa and states reference 20 of Sekizawa communicates to the printer using a warning message. Appellants respectfully submit that the teachings identified by the Office provide no disclosure of any communications of console unit 20 to agent unit 10 or printer P of Sekizawa let alone the specifically claimed receiving the message responsive to the communicating the request. Furthermore, the Examiner at page 11 recites almost the entirety of col. 5 of the Summary of the Invention section and generically states such teachings allegedly disclose communicating a warning message. Appellants have failed to uncover any teachings to a message in col. 5. Furthermore, Appellants have electronically searched Sekizawa and failed to uncover any teachings of communicating a "warning message." The prior art fails to disclose the claimed *receiving the message responsive to the communicating the request* and claim 9 is allowable for at least this additional reason.

Finally, claim 9 recites communicating the message using the image forming device in addition to the claimed receiving the message. Accordingly, claim 9 recites two steps of receiving the message and communicating the message. Even if printer P of Sekizawa receives a message from console 20 (which is not taught by the prior art), the single receiving fails to disclose or suggest the plural steps of the claimed receiving the message and communicating the message using the image forming device. Claim 9 is allowable for this additional reason.

Appellants respectfully submit that each of the numerous above-identified limitations are not disclosed by the prior art. Appellants respectfully submit that any of the numerous limitations not disclosed by the prior art is sufficient to render the claims patentable over the prior art and in combination the numerous limitations

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absent from the prior art illustrate the patentability of the claims over the prior art. Appellants respectfully request withdrawal of the anticipation rejection and allowance of the claims for the reasons herein as well as the reasons in the Brief of Appellants.

**B. The 102 Rejection of Claims 17-23 and 29.**

Appellants submit the following limitations of claim 17 are not disclosed nor suggested by Sekizawa and the anticipation rejection is improper for at least this reason.

Communication of status information  $\phi_1$  by the printer P fails to disclose or suggest the claimed *communicating the request using the image forming device*. Agent unit 10 communicating the status mail  $\phi_2$  fails to disclose or suggest any communications of an image forming device. Furthermore, communications of the status mail by agent unit 10 fails to disclose communicating the *request* as claimed. Appellants respectfully submit the 102 rejection of claim 17 is improper for at least this reason.

Also, the Office baldly alleges on page 12 of the Office Action without reference to teachings in Sekizawa that console 20 of Sekizawa represents a terminal of an external marketing system. Appellants have *electronically searched* Sekizawa and have failed to uncover any reference therein to "marketing" let alone the claimed communicating the request to the marketing system. Appellants respectfully submit the rejection of the claims is improper for at least this additional reason.

In addition, Appellants respectfully submit that Sekizawa fails to teach or suggest the claimed *communicating the message using the marketing system responsive to receiving the request*. On pages 12-13 of the Examiner's Answer, the Examiner relies upon the interpretation of Sekizawa in support of the rejection of claim 9 as allegedly disclosing the claimed communicating of claim 17. Initially, Appellants note that the claimed communicating the message using the marketing system is not defined in claim 9. In addition, the teachings of Col. 19, lines 6-14 and Col. 5, lines 14-50 of Sekizawa fail to disclose any communicating of monitor unit 20 to a printer/machine user a warning message as alleged by the Examiner in

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support of the rejection of claim 9. Appellants have electronically searched Sekizawa and failed to uncover any teachings of communicating a warning message. The Examiner recites statements about the alleged teachings of Sekizawa at page 13 of the Action without any support by the prior art teachings. Sekizawa fails to disclose or suggest console 20 communicating the message responsive to receiving a request and claim 17 is allowable for this additional reason.

Claim 17 recites *communicating the message using the image forming system* in addition to the claimed *communicating the message using the marking system*. Col. 5, lines 14-50 of Sekizawa relied upon by the Office on page 13 of the Action are void of printer teachings and fails to disclose the communicating the message using the image forming device. Sekizawa fails to disclose or suggest a "warning message" as baldly alleged by the Office. Finally, even if Sekizawa were to disclose console 20 communicating a message to a printer, there is no teachings of the printer communicating the message and the single act of communicating from console 20 to the printer P (which is not taught) fails to disclose the plural claimed communicating steps positively recited in claim 17. Limitations of claim 17 are not disclosed nor suggested by the prior art and claim 17 is allowable for at least this reason.

Appellants respectfully submit that each of the numerous above-identified limitations are not disclosed by the prior art. Appellants respectfully submit that any of the numerous limitations not disclosed by the prior art is sufficient to render the claims patentable over the prior art and in combination the numerous limitations absent from the prior art illustrates the patentability of the claims over the prior art. Appellants respectfully request withdrawal of the anticipation rejection and allowance of the claims for the reasons herein as well as the reasons in the Brief of Appellants.

**C. The 102 Rejection of claims 10 and 18.**

The Examiner's Answer at pages 4-9 repeats the arguments of the Office in the Final Office Action dated August 24, 2005. Thereafter, on page 13 spanning to page 14, line 11 of the Examiner's Answer, the Office repeats the same arguments in support of the rejection of claims 10 and 18. Appellants respectfully submit that the rationale provided in the Office action dated August 24, 2005 and replicated

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twice in the Examiner's Answer fails to establish a proper 102 rejection for at least the reasons set forth in the Brief of Appellants.

Referring to the portion of the Examiner's Answer at the bottom of page 14 with respect to reading limitations of the specification into the claims, the Examiner has apparently misconstrued Appellants' remarks in the Brief of Appellants. In particular, Section C of the Brief of Appellants makes clear that teachings of Sekizawa relied upon by the Office fail to disclose the limitations of the claims. Instead of relying upon specific teachings of the detailed description of Sekizawa, the Office has instead chosen to rely upon the generic, unspecific teachings in col. 9 of Sekizawa. Appellants in Section C of the Brief of Appellant assert that not only does the Summary of Invention of col. 9 of Sekizawa fail to disclose the specific limitations of the claims, but fails to disclose how status information of the consumable is obtained. Also, the claims 10 and 18 positively recite "accessing the condition associated with the operation of the image forming device from the consumable" when such claims are properly read in conjunction with the independent claims from which they depend.

As set forth in the Brief of Appellants, the teachings of Sekizawa relied upon by the Office as allegedly disclosing the limitations of the claims fail to disclose the limitations of the claims. The replication of the arguments from the August 24, 2005 Office Action in the Examiner's Answer and the continued failure of the Examiner to identify teachings in the prior art of the claimed accessing a condition associated with an operation of the image forming device from the consumable illustrates the erroneous nature of the 102 rejection of the claims.

Appellants respectfully request withdrawal of the anticipation rejection and allowance of the claims for the reasons herein as well as the reasons in the Brief of Appellants.

**D. The 102 Rejection of Claims 16 and 23.**

Fig. 3 of Sekizawa described at col. 20, lines 36+ refer to operations of the agent unit 10. As claimed from the teachings of Fig. 3, no image forming capabilities are provided by the agent unit 10. The teachings of the agent unit 10 with respect to Fig. 3 and cols. 20-21 thereof fail to disclose or suggest steps of an image forming device let alone the specifically claimed communicating the request

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using the image forming device and including an identifier of the image forming device.

Appellants respectfully request withdrawal of the anticipation rejection and allowance of the claims for the reasons herein as well as the reasons in the Brief of Appellants.

**E. The 102 Rejection of Claim 23.**

The Examiner's Answer recites teachings in col. 19, lines 15-35 of Sekizawa as allegedly disclosing limitations of claim 23 including selecting the message from a plurality of other messages using the identifier, and wherein the communicating the message comprises communicating the message after the selecting. However, these teachings of col. 19 fail to refer to selection of a message from plural messages or communicating the message after the selecting using a marketing system. At page 16, line 6 of the Examiner's Answer, the Examiner baldly alleges that console unit 20 selects messages. However, the Examiner has failed to identify any teachings of Sekizawa of console unit 20 selecting a message from plural messages. Appellants respectfully submit this limitation is not disclosed by the prior art and the rejection is in error.

The teachings in col. 35, lines 16-27 of Sekizawa also referred to on page 16 of the Examiner's Answer refer to reading of unread emails and thereafter extracts printer information from the read pieces. These teachings are opposite to the claimed selecting the message from other messages using an identifier. Furthermore, the teachings relied upon by the Office fail to disclose or suggest *communicating the message after the selecting* as claimed.

Appellants respectfully request withdrawal of the anticipation rejection and allowance of the claims for the reasons herein as well as the reasons in the Brief of Appellants.

**F. The 103 Rejection of Claims 25-26 and 30.**

Appellants assert there is no motivation to combine the reference teachings for the reasons set forth in the Brief of Appellants. Furthermore, even if Sekizawa and Hayward "are directed to the same field of endeavor" as alleged by the Office on page 17 of the Examiner's Answer, such is insufficient to establish motivation to

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combine the reference teachings in view of MPEP §2143.01III (8th ed., rev. 3) citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) providing the mere fact that references *can* be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*.

At page 18 of the Examiner's Answer, there is no evidence of record to support the bald allegation of the Office on page 18 of the Examiner's Answer that the combination is proper because it would "definitely result" in faster action. Sekizawa already discloses obtaining status information at every minute intervals col. 22, lines 7+ and immediately dispatching maintenance personnel at col. 22, lines 15+. There is no evidence of record of any improvement being provided to the system of Sekizawa by the proposed modification let alone any evidence that the modification would "definitely result" in faster action to motivate one to combine the reference teachings, let alone, to completely modify the comprehensive polling arrangement of Sekizawa to a push system. The drastic changes to Sekizawa to operate per the Examiner's combination changes; the principle of operation of Sekizawa and illustrates the inappropriateness of the 103 rejection under MPEP 2143.01VI (8th ed., rev. 3). Furthermore, at page 19 of the Examiner's Answer, there is no evidence of record that downtime of a printer is reduced by the combination proposed by the Office. Sekizawa provides monitoring at minute intervals and immediate dispatch of maintenance personnel and there is no evidence of record that such teachings are deficient or result in delays in the system of Sekizawa to motivate one to look for corrective teachings.

With respect to *In re Fine* recited on page 19 of the Action, there is no objective teachings which would lead an individual to combine the teachings. With respect to the recitation to *In re Bozek*, the limitations of the claims have not been established to be knowledge in the art. With respect to *In re Beattie*, there is no motivation by the prior art taken as a whole inasmuch as there is no resultant advantage nor improvement by the combination of references. There is no evidence of "reduced downtime" nor "better customer service" from the combination as baldly alleged on page 19 of the Action. There is no evidence of reduction of waiting time by the combination as alleged on page 20 of the Action.

Appellants respectfully submit the Office has failed to establish proper

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motivation to combine the reference teachings and Appellants request withdrawal of the 103 rejection and allowance of the claims for the reasons herein as well as the reasons in the Brief of Appellants.

**G. The 103 Rejection of Claim 27.**

Initially, Appellants note that the claim 27 does not imply the limitations as alleged on page 20 of the Examiner's Answer but positively claims receiving a message responsive to the communicating the request and communicating the message using the image forming device comprising printing the message upon paper. Appellants traverse any reliance upon Official Notice because the Office has failed to identify any prior art reference which performs the claimed combination of steps of communicating a request responsive to monitoring an operation of an image forming device using an image forming device, receiving a message responsive to the communicating the request, and communicating the message comprising printing the message upon paper using the image forming device as defined in claim 27. The printing of received fax messages fails to demonstrate that the claimed combination is obvious and it is immaterial to obviousness if all the limitations of the claimed combination are old in other contexts because what must be found obvious to defeat allowability of a patent claim is the claimed combination. *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F. 2d 1437, 1488 (Fed. Cir. 1984). None of the references identified on page 21 of the Examiner's Answer are used in context of the claimed combination of claim 9 defining monitoring an operation of an image forming device, communicating the request responsive to the monitoring, receiving the message and communicating the message comprising printing the message upon paper. The reliance upon Official Notice of specific individual limitations of the claim is contrary to the authority of showing that the *claimed combination* is obvious. Appellants respectfully submit that the reliance upon printing upon paper using a facsimile machine without the context of the remaining limitations of the claimed combination is improper and the reliance upon judicial notice in support of the rejection is improper. The limitations of the claims do not merely recite printing on paper but recite specific limitations of printing the message upon paper in combination of additional limitations of the message being received responsive to communicating the request and

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communicating the request responsive to the monitoring the operation of the image forming device.

Appellants respectfully submit the Office has failed to establish a proper *prima facie* 103 rejection of claim 27 and Appellants request allowance of the claim for the reasons herein as well as the reasons in the Brief of Appellants.

#### H. Conclusion

Reversal of the rejections of the claims and allowance of the claims is respectfully requested for at least the reasons discussed herein and the reasons set forth in the Brief of Appellant.

Respectfully submitted,  
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